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DEC 14 2004

OFFICE OF PETITIONS

In re Application of :
Hernandez, Collins, Hollis, :
Schiffer, and Whitley : DECISION REFUSING STATUS
Application No. 10/700,878 : UNDER 37 CFR 1.47(a)
Filed: 4 November, 2003 :
Attorney Docket No. 026032-4626 :

This is in response to the petition filed under 37 CFR 1.47(a) on 9 November, 2004.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.
Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified application was filed on 4 November, 2003, without an executed oath or declaration. Accordingly, on 10 September, 2004, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, requiring an executed oath or declaration, a surcharge for its late filing, and replacement drawings in compliance with 37 CFR 1.84 and 1.121.

In response, on 9 November, 2004, petitioners filed replacement drawings, the present petition, the petition fee and surcharge

and a declaration naming Cynthia Hernandez, Alan Collins, Marne Hollis, Charlotte Schiffer, and Roger Whitley as joint inventors and signed by joint inventors Hernandez, Collins, and Whitley on behalf of themselves and non-signing joint inventors Hollis and Schiffer.

Petitioners assert that a copy of the declaration was sent to each of the non-signing inventors. The letter sent to joint inventor Schiffer was returned as undeliverable, while no response was received from joint inventor Hollis. A copy of the envelope showing the letter to Schiffer was returned as undeliverable is attached.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1) and (2).

In regards to item (1), petitioners have not provided details of the efforts made to locate non-signing inventor Schiffer. Such details should be set forth in an affidavit or declaration of facts by a person having first-hand knowledge of the details. Additionally, petitioners may show diligent efforts by use of a national registry or other database to determine a current address for the non-signing inventor. If a more recent address is discovered, petitioners should send or give a copy of the application papers to the inventor at that address. If repeated attempts to contact the non-signing inventor are unsuccessful, petitioners will have shown that despite diligent efforts, the inventor could not be reached.

Furthermore, since the letter sent to joint inventor Hollis was not returned as undeliverable, it is presumed that the inventor received it and is not unavailable. As such, before a *bona fide* refusal can be shown, petitioners must provide proof that a copy

of the application as filed (specification, including claims, drawings, if any, and the declaration) was sent to Hollis, but that she refused, either orally or in writing, to sign the declaration or did not return it.

If there is a written refusal, a copy of the written refusal should be submitted with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts. If the application is returned as undeliverable, petitioners should present a copy of the envelope showing that the application sent to the last known address of the non-signing inventor was returned as undeliverable by the post office.

In regards to item (2), the declaration contains is defective in that it contains non initialed and/or non-dated alterations.¹ Specifically, there is an uninitialed and/or undated alteration in the signature block(s) for joint inventor Collins. It is further noted that the copy of the declaration signed by Hernandez contains Collins' signature block on Page 4 of 5, while the declaration signed by Whitley contains Collins' signature block on Page 5 of 5. A new oath or declaration in compliance with 37 CFR 1.63 and 1.67, signed by the inventor to whom the error or deficiency relates is required.²

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 220 20th Street S.
 Customer Window, Mail Stop Petitions
 Crystal Plaza 2, Lobby, Room 1B03
 Arlington, VA 22202

¹See 37 CFR 1.52(c).

²37 CFR 1.67(a)(2).

The address listed on the petition is different than the correspondence address of record. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.



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cc: Foley & Lardner LLP
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